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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/625,151

07/23/2003

Glen J. Anderson

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09/18/2008

GATEWAY, INC.

ATTN: Patent Attorney

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EXAMINER

MURDOUGH, JOSHUA A

ART UNIT

PAPER NUMBER

3621

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DELIVERY MODE

09/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/625,151	Applicant(s) ANDERSON ET AL.	
	Examiner JOSHUA MURDOUGH	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 7-22 and 24-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/23/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is responsive to Applicants' response to the restriction requirement received 9 July 2008.
2. Claims 1-33 are pending.
3. Claims 7-22 and 24-33 are withdrawn with this action.
4. Claims 1-6 and 23 have been examined.

Election/Restrictions

5. Claims 7-22 and 24-33 are withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9 July 2008.

Drawings

6. Figure 1 of the drawings is objected to under 37 C.F.R. §1.83(a) because it fails to show “software” as described on page 7, line 2 of the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 C.F.R. §1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the

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appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 C.F.R. §1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 2nd Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 23 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The specification recites that the controller **117** performs all of the means plus function limitations. However, the controller without instructions would not perform anything. Therefore it is unclear as to whether or not there is necessarily a software element to these limitations. Moreover, it is not clear to one of ordinary skill in the art whether the each 'means for' element is hardware only, software only, or a combination of the two.

10. Additionally, It is unclear if there is one (1) processor in the claim or three (3) processors in the claim since each means element includes a processor.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-6 and 23 are rejected under 35 U.S.C. §102(b) as being anticipated by Wyatt (US 6,041,411).

13. As to claim 1, Wyatt shows:

- a. A method comprising:
- b. receiving an identification (at the server) from an electronic device (client computer) (Figure 3, Steps 58 and 62; Figure 8 where the device is identified);
- c. finding a product code (product activation code) associated with the identification (Figure 4, Step 82); and
- d. sending the product code to the electronic device (Figure 3, Step 70) ;
- e. wherein the product code enables use of a product on the electronic device, said product not being usable on the electronic device until being enabled with the product code (Figure 4, Step 38).

14. The Examiner notes that the sending of the product code to the electronic device inherently requires a machine component such as a keypad or communications hardware.

15. As to claim 2, Wyatt further shows:

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copying the product code to a database when the product is purchased (Figure 7).

16. As to claim 3, Wyatt further shows:

the finding the product code further comprises finding the product code in the database (Id.).

17. As to claim 4, Wyatt further shows:

copying the product code to a database when the product and the electronic device are purchased (Figure 4, Step 34; Figure 7).

18. As to claim 5, Wyatt further shows:

the identification identifies the electronic device (Figure 8).

19. As to claim 6, Wyatt further shows:

the identification identifies a customer (Figure 3, Steps 58 and 62).

20. As to claim 23, the “means for” limitations are interpreted as invoking 35 U.S.C. §112 6th paragraph. Therefore, the required structures are to be read into the claims from the specification. For clarity, the Examiner has cited the sections of the specification showing the structures for each of the limitations in square braces (e.g. [processor 130; Page 4, lines 24-25]).

21. As to claim 23, Wyatt shows:

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- f. An apparatus comprising:
 - g. means for receiving [controller 171; Page 12, lines 15-16] (Server 14, interpreted to be a computer, necessarily has a processor, which allows access from the communications sub-system of the server to the other sub-systems) an identification from an electronic device;
 - h. means for finding [controller 171; Page 12, lines 15-16] (Server 14, interpreted to be a computer, necessarily has a processor, which allows access to the storage sub-system of the server in order to look up information in the storage) a product code associated with the identification; and
 - i. means for sending [controller 171; Page 12, lines 15-17] (Server 14, interpreted to be a computer, necessarily has a processor, which allows access to the communications sub-system of the server) the product code to the electronic device;
 - j. wherein the product code enables use of a product on the electronic device, said product not being usable on the electronic device until being enabled with the product code (Figure 4, Step 38).
22. The Examiner notes that software is also required, in the instant invention as well as the reference, to have the controller perform anything. This is shown in the specification on page 7, lines 2-6. Wyatt shows the associated functionality and therefore, at least inherently, shows the software.

Definitions

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23. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.¹ Moreover, while the following list is provided in accordance with *In re Morris* (127F.3d 1048, 44 USPQ2d 1023 (Fed. Cir 1997)), the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

Controller: “A device on which other devices rely for access to a computer sub-system.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

Server: “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

¹ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

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26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.

Examiner, Art Unit 3621

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621